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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/624,619 07/24/00 OKAMOTO

K CANO:011

QM22/1023

EXAMINER

ROSSI & ASSOCIATES
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ASHBURN VA 20146-0826

GOODMAN, C

ART UNIT

PAPER NUMBER

3724

6

DATE MAILED:

10/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/624,619

Applicant(s)

OKAMOTO ET AL.

Examiner

Charles Goodman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-3, drawn to a sheet processing apparatus and means for determining.
 - II. Claims 1, 2, and 5, drawn to a sheet processing apparatus and specifics of the movement amount detecting means.
 - III. Claims 1, 2, and 6, drawn to a sheet processing apparatus and specifics of the movement amount detecting means.
 - IV. Claims 1 and 4, drawn to a sheet processing apparatus and a movement starting means.
 - V. Claims 1, 7, and 8, drawn to a sheet processing apparatus and the specifics of the movement amount detecting means.
 - VI. Claim 9, drawn to a sheet processing method.
 - VII. Claim 10, drawn to a computer storage medium.
 - VIII. Claims 11 and 12, drawn to a sheet processing apparatus and specifics of the control means.
 - IX. Claims 11, 13, and 14, drawn to a sheet processing apparatus and specifics of the sheet processing means and control means.
 - X. Claims 11, 13, and 15, drawn to a sheet processing apparatus and specifics of the control means.

- XI. Claims 11 and 16-18, drawn to a sheet processing apparatus and specifics of the sheet processing means.
- XII. Claims 11 and 19, drawn to a sheet processing apparatus and specifics of the control means.
- XIII. Claims 11 and 20, drawn to a sheet processing apparatus and punching process means.
- XIV. Claims 11 and 21, drawn to a sheet processing apparatus and specifics of the sheet processing means.
- XV. Claims 11, 22, and 23, drawn to a sheet processing apparatus and an image forming apparatus.
- XVI. Claim 24, drawn to a method of controlling a sheet processing apparatus.
- XVII. Claim 25, drawn to a computer storage medium.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions VI and I-V are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the process as claimed can be practiced by another materially different apparatus that does not require the means for determining.

3. Inventions I-V and VII are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other

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combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination as claimed does not require the computer-readable storage medium and program of the subcombination as evidenced by the lack thereof in the combination. The subcombination has separate utility such as in a sheet processing apparatus that does not require means for determining.

4. Inventions XVI and VIII-XV are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the process as claimed can be practiced by another materially different apparatus that does not require the control means to determine timing based upon the length of the sheet.

5. Inventions VIII-XV and XVII are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination as claimed does not require the computer-readable storage medium and program of the subcombination as evidenced by the lack thereof in the combination. The subcombination has separate utility such as in a sheet processing apparatus that does not require control means to determine timing based upon the length of the sheet.

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6. Groups I-V are distinct from Groups VIII-XV because they do not require the particulars of Groups VIII-XV. For example, Groups I-V do not require the control means of Groups VIII-XV for patentability as evidenced by the lack thereof in Groups I-V.
7. Groups VIII-XV are distinct from Groups I-V because they do not require the particulars of Groups I-V. For example, Groups VIII-XV do not require the sheet means of Groups I-V for patentability as evidenced by the lack thereof in Groups VIII-XV.
8. Group I is distinct from Groups II-V because it does not require the particulars of Groups II-V. For example, Group I does not require the detection of the trailing end; the detection of the leading end; the means for determining punching position; and detection of period of time of Groups II-V for patentability as evidenced by the lack thereof in Group I.
9. Group II is distinct from Groups I and III-V because it does not require the particulars of Groups I and III-V. For example, Group II does not require the minimum size; the detection of the leading end; the means for determining punching position; and detection of period of time of Groups I and III-V for patentability as evidenced by the lack thereof in Group II.
10. Group III is distinct from Groups I-II and IV-V because it does not require the particulars of Groups I-II and IV-V. For example, Group III does not require the minimum size; the detection of the trailing end; the means for determining punching position; and detection of period of time of Groups I-II and IV-V for patentability as evidenced by the lack thereof in Group III.

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11. Group IV is distinct from Groups I-III and V because it does not require the particulars of Groups I-III and V. For example, Group IV does not require the minimum size; the detection of the trailing end; the detection of the leading end; and detection of period of time of Groups I-III and V for patentability as evidenced by the lack thereof in Group IV.

12. Group V is distinct from Groups I-IV because it does not require the particulars of Groups I-IV. For example, Group V does not require the minimum size; the detection of the trailing end; the detection of the leading end; and the means for determining punching position of Groups I-IV for patentability as evidenced by the lack thereof in Group V.

13. Group VIII is distinct from Groups IX-XV because it does not require the particulars of Groups IX-XV. For example, Group VIII does not require the capability of executing sheet process on plural types of sheets; movable sheet processing means; execution of the sheet process without stopping conveyance; punching process; execution of the sheet process without sheet aligning; and image forming apparatus of Groups IX-XV for patentability as evidenced by the lack thereof in Group VIII.

14. Group IX is distinct from Groups VIII and X-XV because it does not require the particulars of Groups VIII and X-XV. For example, Group IX does not require the determination of time based upon length; setting different values of timing according to sheet type; movable sheet processing means; execution of the sheet process without stopping conveyance; punching process; execution of the sheet process without sheet aligning; and image forming apparatus of Groups VIII and X-XV for patentability as evidenced by the lack thereof in Group IX.

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15. Group X is distinct from Groups VIII-IX and XI-XV because it does not require the particulars of Groups VIII-IX and XI-XV. For example, Group X does not require the determination of time based upon length; timing delay; movable sheet processing means; execution of the sheet process without stopping conveyance; punching process; execution of the sheet process without sheet aligning; and image forming apparatus of Groups VIII-IX and XI-XV for patentability as evidenced by the lack thereof in Group X.

16. Group XI is distinct from Groups VIII-X and XII-XV because it does not require the particulars of Groups VIII-X and XII-XV. For example, Group XI does not require the determination of time based upon length; timing delay; setting different values of timing according to sheet type; execution of the sheet process without stopping conveyance; punching process; execution of the sheet process without sheet aligning; and image forming apparatus of Groups VIII-X and XII-XV for patentability as evidenced by the lack thereof in Group XI.

17. Group XII is distinct from Groups VIII-XI and XIII-XV because it does not require the particulars of Groups VIII-XI and XIII-XV. For example, Group XII does not require the determination of time based upon length; timing delay; setting different values of timing according to sheet type; movable sheet processing means; punching process; execution of the sheet process without sheet aligning; and image forming apparatus of Groups VIII-XI and XIII-XV for patentability as evidenced by the lack thereof in Group XII.

18. Group XIII is distinct from Groups VIII-XII and XIV-XV because it does not require the particulars of Groups VIII-XII and XIV-XV. For example, Group XIII does not require the determination of time based upon length; timing delay; setting different

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values of timing according to sheet type; movable sheet processing means; execution of the sheet process without stopping conveyance; execution of the sheet process without sheet aligning; and image forming apparatus of Groups VIII-XII and XIV-XV for patentability as evidenced by the lack thereof in Group XIII.

19. Group XIV is distinct from Groups VIII-XIII and XV because it does not require the particulars of Groups VIII-XIII and XV. For example, Group XIV does not require the determination of time based upon length; timing delay; setting different values of timing according to sheet type; movable sheet processing means; execution of the sheet process without stopping conveyance; punching process; and image forming apparatus of Groups VIII-XIII and XV for patentability as evidenced by the lack thereof in Group XIV.

20. Group XV is distinct from Groups VIII-XIV because it does not require the particulars of Groups VIII-XIV. For example, Group XV does not require the determination of time based upon length; timing delay; setting different values of timing according to sheet type; movable sheet processing means; execution of the sheet process without stopping conveyance; punching process; and execution of the sheet process without sheet aligning of Groups VIII-XIV for patentability as evidenced by the lack thereof in Group XV.

21. Group VI is distinct from Group XVI because it does not require the particulars of Group XVI. For example, Group VI does not require the control step of Group XVI for patentability as evidenced by the lack thereof in Group VI.

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22. Group XVI is distinct from Group VI because it does not require the particulars of Group XVI. For example, Group XVI does not require the starting moving step of Group VI for patentability as evidenced by the lack thereof in Group XVI.

23. Group VII is distinct from Group XVII because it does not require the particulars of Group XVII. For example, Group VII does not require the control step of Group XVII for patentability as evidenced by the lack thereof in Group VII.

24. Group XVII is distinct from Group VII because it does not require the particulars of Group XVII. For example, Group XVII does not require the starting moving step of Group VII for patentability as evidenced by the lack thereof in Group XVII.

25. If either Groups VI-VII are elected, both will be examined.

26. If either Groups XVI-XVII are elected, both will be examined.

27. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

28. Upon election to one of the Groups above, the following Species restriction also applies.

29. This application contains claims directed to the following patentably distinct species of the claimed invention: Species I shown in Figs. 7-9 and Species II shown in Figs. 12-14.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, it appears that none of the claims are generic.

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Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

30. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

31. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

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remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Goodman whose telephone number is (703) 308-0501. The examiner can normally be reached on Monday-Thursday between 7:30 AM to 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached on (703) 308-2187. The fax phone number for this Group is (703) 305-3579.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [**rinaldi.rada@uspto.gov**].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

cg

October 22, 2001


Charles Goodman
Patent Examiner
AU 3724